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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

APPLICANT: James V. Young **GROUP No.:** 3764
SERIAL NO.: 09/176,866 **EXAMINER:** Demille, Danton D.
FILED: October 22, 1998 **DOCKET NO.:** PHYS 6996
FOR: Massage Apparatus

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

September 24, 2003
St. Louis, Missouri

Attn: Board of Patent Appeals and Interferences

Sir:

Enclosed herewith, in triplicate, is Appellant's Reply Brief, which responds to the Examiner's Answer dated July 25, 2003. It is believed that no fee is due with respect to the enclosed filing. Should any fee be required, the Commissioner is authorized to charge such fee to Deposit Account No. 16-2201. A duplicate copy of this sheet is enclosed. Applicant's Small Entity status has been established on October 19, 1998.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on September 24, 2003.

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Date of Signature: September 24, 2003



PATENT #25
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APPELLANT'S REPLY BRIEF

This reply brief responds to the Examiner's Answer dated July 25, 2003, in the above-designated application. Claims 1-7, 9 and 15-20 are at issue.

I. ARGUMENTS - REJECTIONS UNDER 35 U.S.C. § 102
(CFR 1.192(c)(8)(iv))

The Examiner rejected Claim 1 of the present case as being clearly anticipated by Holt. The Examiner admits that the Holt device is different from the instant invention, but argues that the claims do not define over Holt. However, a "claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Furthermore, the "identical invention must be shown in as **complete** detail as is contained in the ... claim." (Emphasis added) *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). Here, it is clear that the identical invention is not described in as complete detail as is contained in the claims. The Examiner admits this and nevertheless reads

into Holt the structural limitations of Applicant's claims when none of those structural components are shown, described or even vaguely intimated by the Holt specification.

Claims 1 and 15, as amended, are directed to devices comprising an applicator head having a cavity formed therein that is adapted to permit skin to be drawn inwardly of the cavity, the cavity being substantially the size of the end surface. The claimed device also comprises a connection tube that is capable of applying at least a partial vacuum in the cavity such that placement of the head on a human body results in the application of a force combination of mechanical oscillation and suction, the connection including a suction line carried externally of the drive cable, the suction line having a first end operatively connected to the vacuum pump and a second end operatively attached to the connector tube, the connection tube drawing contaminants from the cavity through the connection tube. The claims are not anticipated because all the claim limitations must be taught or suggested by Holt, and neither of these limitations are shown, described or suggested in Holt. Further, the claims are clearly not anticipated because even if the elements are shown in Holt, generally, it is clear that the claimed limitations are not shown in the same detail as claimed. *In re Royka*, 180 USPQ 580 (CCPA 1974).

The only way Holt reads on the appealed claim is if Holt is improperly modified, as the Examiner has done in his rejection. The only disclosure in Holt of the structure upon which the Examiner relies specifically states, "The plate 28 will prevent this material from being drawn into the air passage, the said material being collected within the cup-shaped holder 20." (Holt Col. 2, L 63-66) Claim 1 specifically requires the contaminants to be removed from the cavity. As the Examiner has admitted, applicant's invention is different. Applicant recognizes that a claim presented for examination is to be interpreted broadly – perhaps more broadly than a court

would interpret the same claim in litigation – but the interpretation must be reasonably consistent with the specification. MPEP 2111. The claim must be interpreted as broadly as its terms reasonably allow in, or in other words, the claim must be read as it would be interpreted by those of ordinary skill in the art. MPEP 2111.01. It seems inconceivable that one of ordinary skill would equate a construction specifically intended “to pass contaminants from the cavity,” as required by the independent claims on appeal, with a construction where the “material being collected within the cup-shaped holder 20,” described by Holt. Hence, the structure recited in claims 1 and 15 is novel.

Since all the subject matter of Claim 1 is not taught or suggested by Holt, Claims 1 and 15 are patentable over Holt. *Id.* Therefore, reversal of the rejection of Claim 1 and Claim 15 under 35 USC §102(b) is respectfully requested.

II. ARGUMENTS – REJECTIONS UNDER 35 USC 103 (a)

Claims 2-5 were rejected under 35 U.S.C. §103(a) as being unpatentable over Holt. Claims 2-5 depend from Claim 1, and therefore incorporate all of the limitations therein. Claim 1 is submitted to be both novel and non-obvious for the reasons set forth above. It is submitted that Claims 2-5 are nonobvious and allowable for the same reasons. Accordingly, since dependent Claims 2-5 merely add additional limitations to independent Claim 1, Claims 2 -5 are patentable under 35 U.S.C. § 103(a). *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). Therefore, it is respectfully requested that the rejection of Claims 2-5 under 35 U.S.C. §103(a) be reversed.

Claims 6, 7, 9 and 15-20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Holt in view of Marshall et al. and Rohrer. Claims 6, 7, 9 and 15-20 depend either directly or indirectly from independent Claim 1, or independent claim 15, and therefore include all of the

subject matter therein. Claims 1 and 15 are seen as non-obvious, novel and allowable in view of the discussion above. Accordingly, since dependent claims 6, 7, 9 and 15-20 merely add additional limitations to independent Claims 1 and 15, they are likewise patentable under 35 U.S.C. §103(a). *Id.*

Further, the Examiner argues that although Holt is silent with regard to the details of the controls of the motor and the concave shape of the applicator, Claims 6, 7, 9 and 15-20 are still obvious in view of Holt. However, to establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (CCPA 1974). In fact, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970). Here, there are claim limitations in independent Claims 1 and 15 that are clearly not taught by the art cited by the Examiner. Claims 1 and 15 are directed to a device comprising an applicator removably mounted to a massage head, the applicator having a concave shaped cavity formed in an end surface of it, a connection tube attached to the applicator that is capable of applying at least a partial vacuum to the cavity so as to draw and stretch fibrous tissue within substantially the entire cavity, the cavity having a size about the size of the end surface and a vacuum line connected between the connection tube of the applicator and the vacuum pump, said vacuum line drawing contaminates from the cavity through said connection tube. These limitations simply are not taught by the prior art.

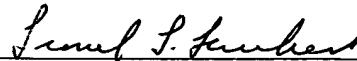
Further, even if the references cited by the Examiner teach each and every limitation of Claims 1 and 15, obviousness can only be established by combining or modifying the teachings of the prior art where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the

art. *In re Fine*, 837 F.2d at 1071. Here, the Examiner has not shown a motivation to combine the reference teachings either in the references themselves, or in the knowledge generally available in the art.

Since the Examiner has failed to establish a *prima facie* case of obviousness of Claims 1 or 15, reversal of the rejection of Claims 1 and 15 is respectfully requested.

Claims 6, 7, 9 and 16-20 each depend either directly or indirectly from independent Claims 1 and 15, which are seen as allowable in view of the discussion above. Accordingly, since these dependent claims merely add additional limitations to independent Claims 1 and 15, they are seen as patentable under 35 U.S.C. §103(a). *In re Fine*, 837 F.2d at 1071.

Respectfully submitted,



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